

REMARKS

By the present amendment, the specification has been amended to describe the main unit 101 in terms of a sample processing apparatus for processing the sample and including at least one chamber therein. Additionally, independent claims 9, 11 and 13 have been amended to recite "calculating means for calculating and simulating" or similar means plus function language in light of the Examiner's position concerning the previous recitation in claim 9, for example, of "a calculator which calculates and simulates", which position by the Examiner is improper, as will be discussed below. Additionally, the independent claims have been amended to recite the feature that the simulated operation or result includes occurrence of an abnormality as previously set forth in the dependent claims with the dependent claims being amended in accordance with the language of the parent claims. Also, new dependent claims 15 - 17 have been presented which recite the feature of the display displaying information about the abnormality.

The rejection of claims 9 - 14 under 35 USC 102(b) as being anticipated by Yoshida et al (US Patent 4,964,734) is traversed insofar as it is applicable to the present claims and reconsideration and withdrawal of the rejection are respectfully requested.

As to the requirements to support a rejection under 35 USC 102, reference is made to the decision of reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular

element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In setting forth the rejection based upon Yoshida et al, the Examiner indicates that Yoshida et al meets all of the structural limitations and "the functional recitation (for, which) that has not been given patentable weight because it is narrative in form". The Examiner contends that in order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function. Applicants submit that this position by the Examiner is improper in that all limitations of a claim must be given patentable weight, noting that the Examiner's citation of a 1929 decision does not relate to the 1952 patent act. The Examiner is referred to the decision of In re Swinehart and Sfiligoj, 169 USPQ 226 (CCPA 1971) wherein the Court pointed out that the Court sees no merit in any proposition which would require the denial of the claim solely because of the type of language used to define the subject matter for which patent protection is sought. Thus, the Court indicated that "functional" indicates nothing more than the fact that an attempt is being made to define something by what it does rather than by what it is and that there is nothing intrinsically wrong with the use of such technique in drafting patent claims. Thus, it is apparent that the language cannot be disregarded and given no patentable weight where the claims described the operation of the calculator.

However, to avoid this question concerning patentable weight, the independent claims have been amended to recite a calculating means for calculating and simulating, as recited in independent claim 9, for example, the operation executed by the main unit using the predetermined data recorded during the operation which was executed by the main unit according to an instructions, which is given by user of the sample processing apparatus after the operation which was executed by the main unit, it being noted that claim 9 also recites a display which is located remotely from the main unit and displays the simulated operation simulated by the calculating means including occurrence of an abnormality. As noted above, independent claims 11 and 13 have been amended in a similar manner and applicants submit that it is apparent that the recited so-called functional features cannot be disregarded.

Applicants submit that in accordance with the present invention since a user can recognize from the display information of operation such as a condition of the apparatus of processing, after processing of the sample, especially the operating condition of the apparatus when an abnormality has occurred so as to take appropriate steps in a relative short time period to enable proper operation of the apparatus. In the prior art, as described in the specification of this application, it is often difficult for the user to determine the condition of the apparatus at the time of occurrence of an abnormality, correctly in a short time, after the occurrence of the abnormality by operating the apparatus again since the operational condition is different from the time of the occurrence of the abnormality and there is the possibility of increasing damage of the apparatus. By the present invention, the prior operation of the apparatus is calculated and simulated information is supplied to the user based upon the user instruction so as to enable the user to make a correct

determination of cause of an abnormality in a short time. Applicants submit that Yoshida et al fails to provide the claimed features as set forth in independent claims 9, 11 and 13 and the dependent claims in the sense of 35 USC 102, as will become clear from the following discussion.

Irrespective of the Examiner's position concerning Yoshida et al, applicants submit that Yoshida et al is directed to a moisture content measuring system and not a sample processing apparatus, diagnosis apparatus or a program, as recited in the claims of this application. In accordance with Yoshida et al as described in the paragraph bridging columns 4 and 5 thereof, a sample in the form of coal is picked up in the sample container 5, is weighed by a weighing instrument 7 and heaters and fans are turned on, and a signal representing a variation of the weight of the sample caused by drying is sent via an A/D converter 14 to a calculator 15 to calculate a moisture content value thereof. A moisture content value changing moment by moment is indicated by the digital indicator 16 and the results of measurement are transmitted to a display-recorder 17 in a boiler operating room. Assuming, arguendo, that Yoshida et al may be considered to have a main unit and a recording device, it is readily apparent that Yoshida et al in the sense of 35 USC102 does not disclose calculating means operating in the manner defined nor a display operating in the manner defined, which displays the simulated result including occurrence of an abnormality, as simulated by the calculating means and which features are recited in independent claims 9, 11 and 13. Thus, as pointed out in the decision of In re Robertson, supra, each and every feature of the claim must be shown in a single reference. Clearly, Yoshida et al does not disclose in the sense of 35 USC 102 or teach in the sense of 35 USC 103 the recited features of the independent and dependent claims of this application.

With regard to claims 13 and 14, the Examiner contends that Yoshida et al does not positively disclose the program for a sample processing apparatus, it is inherent property of Yoshida et al. Hereagain, reference is made to the decision of In re Robertson, supra, regarding the requirements to showing inherency and the Examiner's statement lacks any basis in fact and applicants' question any utilization of a program operating in a manner defined in Yoshida et al. Thus, applicants submit that claim 13 and its dependent claims also patentably distinguish over Yoshida et al in the sense of 35 USC 102.

With regard to the dependent claims, applicants note that the dependent claims recite additional features, which when considered in conjunction with the parent claims, further patentably distinguish over Yoshida et al in the sense of 35 USC 102 and 35 USC 103. Thus, the dependent claims should also be considered to patentably distinguish over the cited art and should be considered allowable at this time.

In view of the above amendments and remarks, applicants submit that all claims present in this application should now be in condition for allowance and issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli,

Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 500.41300X00),
and please credit any excess fees to such deposit account.

Respectfully submitted,

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